

PATENT

Serial No. 10/538,106

Amendment in Reply to Office Action of December 29, 2008

REMARKS

This Amendment is being filed in response to the Office Action mailed on December 29, 2009, which has been reviewed and carefully considered. Reconsideration and allowance of the present application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 10-21 are pending in the application, where claims 1-9 have been canceled without prejudice and claim 18-21 have been added. Claims 10 and 19 are independent. Applicants reserve the right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or continuing applications.

In the Office Action, the Examiner objected to the specification for a certain informality. In response, the specification has been amended to remove the informality noted by the Examiner. Accordingly, withdrawal of the objection to the specification is respectfully requested.

In the Office Action, claims 10-12 are rejected under 35

U.S.C. §112, first paragraph. This rejection is respectfully traversed. However, to advance prosecution, claim 10 has been amended for conformance with the specification. It is respectfully submitted that this rejection of claims 10-12 has been overcome. Accordingly, withdrawal of this rejection is respectfully requested.

In the Office Action, claims 10-14 and 17 are rejected under 35 U.S.C. §112, second paragraph. This rejection is respectfully traversed. However, to advance prosecution, claims 10-14 and 17 have been amended for better clarity. It is respectfully submitted that this rejection of claims 10-14 and 17 has been overcome. Accordingly, withdrawal of this rejection is respectfully requested.

In the Office Action, claims 9-10 and 13-17 are rejected under 35 U.S.C. §102(b) over U.S. Patent No. 6,285,513 (Tsuji). Further, claim 11 is rejected under 35 U.S.C. §103(a) over Tsuji in view of U.S. Patent No. 3,624,030 (Pruvost). Claim 12 is rejected under 35 U.S.C. §103(a) over Tsuji in view of U.S. Patent No. 3,197,433 (Lamoraux). Applicants respectfully traverse and submit that

claims 10-21 are patentable over Tsuji, Pruvost and Lamoraux for at least the following reasons.

Tsuji is directed to an optical element comprising a silicon based resin satisfying three particular conditional formulas. On page 5 of the Office Action, paragraph three, it is alleged that column 15, line 64 to column 7, line 59 of Tsuji discloses the second component (2), which has a vinyl group ($\text{CH}=\text{CH}_2$) at both ends of the component.

It is respectfully submitted that Tsuji does not disclose or suggest the present invention as recited in independent claim 10, and similarly recited in independent claim 19 which, amongst other patentable elements, recites a particular second composition (2) that includes a vinyl group ($\text{CH}=\text{CH}_2$) at both ends of the component. This feature is nowhere disclosed or suggested in Tsuji. Rather, at best, Tsuji discloses a vinyl group at only one end of a compound, such as on column 12, lines 41, 55 and 61. Pruvost and Lamoraux are cited in rejecting dependent claims to allegedly show other features and do not remedy the deficiencies in Tsuji.

Accordingly, it is respectfully requested that independent

claims 10 and 19 be allowed. In addition, it is respectfully submitted that claims 11-18 and 20-21 should also be allowed at least based on their dependence from independent claims 10 and 19 as well as their individually patentable elements. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

For example, as correctly noted in the Office Action, Tsuji does not disclose or suggests the features of claims 11-12. Pruvost and Lamoraux are cited to allegedly show these features. Assuming, arguendo, that Pruvost and Lamoraux disclose the features of claims 11-12, it is respectfully submitted that there is no motivation or suggestion to combine Tsuji with Pruvost and Lamoraux, absent the teaching of the present patent application. The only suggestion that can be found anywhere for making these combinations appears to come from the present patent application itself.

It is clear that the suggestion to combine references should not come from the Applicants, as was forcefully stated in Orthopedic Equipment Co. v United States, 217 U.S.P.Q. 193, 199

(C.A.F.C. 1983): "It is wrong to use the patent in suit [here the application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]."

The Office Action states that the motivation for combining Tsuji and Pruvost is that "[t]he motivation to provide these end groups is to provide an additional reactive site by which the silicon based reactive material can undergo condensation reaction and thereby polymerize." (See, Office Action, page 7, paragraph two, last three lines.) Yet, this position finds no support in either of Tsuji and Pruvost (or Lamoraux). Further, there are innumerable compounds to mix to form a silicon based reactive material, and the particular mixtures recited in claims 11-12 and 19 can only be arrived at using impermissible hindsight. It is respectfully submitted that making up some arbitrary motivation to arrive at a particular mixture of components is not evidence of a proper motivation for altering Tsuji, Pruvost and Lamoraux in a way

that is not contemplated by them.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

In view of the above, it is respectfully submitted that the present application is in condition for allowance, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

By Dicran Zelj
Dicran Halajian, Reg. 39,703
Attorney for Applicant(s)
March 24, 2009

THORNE & HALAJIAN, LLP
Applied Technology Center
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101